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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,435	11/15/1999	PETER ROCHE	12002	1637

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HOWARD & HOWARD ATTORNEYS, P.C.  
THE PINEHURST OFFICE CENTER, SUITE #101  
39400 WOODWARD AVENUE  
BLOOMFIELD HILLS, MI 48304-5151

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

13

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/439,435

Applicant(s)

Roche et al.

Examiner

Rabon Sergeant

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 5, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-16 is/are pending in the application.
- 4a) Of the above, claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Claims 1, 2, and 7-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Despite applicants' response, applicants have failed to define exactly how the "structurally distinct" language of claim 1 is to be interpreted. It is unclear what level of distinctness is conveyed by the language; for example, does the language pertain only to the exclusion of identical compounds or constituents?
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1, 2, 7-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwindt et al. ('423) or Grogler et al. ('497).

Patentees disclose polyurethane casting compositions suitable for producing molded elastomeric coverings, comprising the reaction product of a polyisocyanate and a propylene oxide derived polyether polyol, wherein the polyol is present in an amount which overlaps the amount claimed for applicants' first polyol. See abstract; column 4, lines 3-21, 67, and 68; column 5, lines 1-12; and column 7, lines 51-63, within Schwindt et al. See abstract; column 11, lines 3-22; and example 3, within Grogler et al. It is noted that applicants' mixture (b1) is open to the inclusion of additional components.


4. Patentees differ from applicants in that applicants require a positive amount of an amine initiated polyether polyol be present. Patentees fail to recite such a component; however, the position is taken that the claimed positive amount of the amine initiated polyether polyol is close enough to zero that one would have reasonably expected the respective compositions to have the same properties, at the low end of the second polyether polyol's range. It has been held that a *prima facie* case of obviousness exists where the claimed ranges are close enough that one would have expected the compositions to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Applicants' have provided no guidance with respect to the quantity of compounds which are present which are governed by the language, "a positive amount". In the absence of such guidance, the examiner considers that such components may be present in trace or nearly undetectable amounts; therefore, one would have

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expected such minuscule amounts of reactants to have an insignificant impact on the properties of the composition. Accordingly, this position is considered to be in line with the findings of the recited decision. Furthermore, applicants' examples have been carefully considered; however, the quantity of the amine initiated polyol in example 3 is significant and not comparable to the low end of the quantity range within claim 1. Therefore, applicants' arguments with respect to the properties of the respective compositions are not commensurate in scope with the claims.

Lastly, the rejection has been expanded to include claims 9, 11, 15, and 16, because these claim limitations govern only the structure of the compounds, rather than their quantities. Accordingly, given the aforementioned position concerning the quantities of argued constituents, the aforementioned decision is considered to be relevant regardless of the structure of the compounds.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

R. Sergent

April 13, 2003